

Appl. No. 10/722,847
Docket No. 14XZ130600/GEM-0104

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REMARKS / ARGUMENTS

Status of Claims

Claims 1-16 are pending in the application and stand rejected. Applicant has made no further amendments to the claims, leaving Claims 1-16 for reconsideration in view of the remarks set forth below. No claim amendments have been made, and therefore under 37 CFR 1.121, no claim listing is provided herewith.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been overcome, that no new matter has been entered, and that the application is in condition for allowance.

Rejections Under 35 U.S.C. §102(b)

Claims 1, 2, 13 and 16 stand rejected under 35 U.S.C. §102(b) as being anticipated by Takanashi (U.S. Patent No. 6,243,096, hereinafter Takanashi).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*" *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the *** claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

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Regarding Independent Claims 1, 13 and 16

In alleging anticipation, the Examiner alleges that Takanashi discloses each and every element of the claimed invention arranged as claimed, and more specifically alleges that Takanashi discloses “means (12, figs.2 and 3) for actuating by direct manual input by a hand of the user to control the means for processing to switch from one operating mode (i.e., three-dimensional operating mode) where the gripping element is used for manipulating images to an operating mode (i.e., two-dimensional operating mode) where the device is used as a pointer or for selection and vice versa (col. 9, line 44 to col. 10, line 21).” Paper No. 20070130, page 2.

As best understood by Applicant, it appears that the Examiner is alleging that Takanashi *element 12* (three operating buttons of mouse 14) is disclosed *to switch the means for processing (computer 15) from one operating mode, where the gripping element is used for manipulating images, to another operating mode, where the device is used as a pointer or for selection* and vice versa. That is, the Takanashi buttons 12 are allegedly used to switch the computer between an image manipulation mode and a pointer/selection mode.

As further understood by Applicant, it appears that the Examiner is also alleging that Takanashi *element 12* is disclosed *to operate in a mode where the gripping element is used for manipulating images.*

Applicant respectfully disagrees with the Examiner on both counts.

First, and in comparing Takanashi with the claimed invention, Applicant finds Takanashi to disclose a mouse 14 having three operation buttons 12, where one of the buttons 12 serves as an input-mode selection switch *12 for selecting one of the input modes* (col. 9, lines 44-47). Takanashi discloses the *three input modes* to be first, second and third input modes (col. 10, lines 52-65). The *first input mode* (Figs. 4A and 4B) serves to *correspond translational motions* X_M and Y_M of the mouse 14 *with translational motions* along the X_C and Y_C coordinates axes defined on the main cursor 10. (col. 10, lines 52-55). The *second input mode* (Figs. 5A and 5B) serves to *correspond the X_M translational motion* of the mouse 14 with *rotational motion* around

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the coordinate axis Z_C of the main cursor 10. (col. 10, lines 56-61). The *third input mode* (Figs. 6A and 6B) serves to *correspond translational motions* X_M and Y_M of the mouse 14 with *rotational motions* around the coordinate axes Y_C and Z_C of the main cursor 10. (col. 10, lines 62-65).

Here, Applicant finds Takanashi to disclose element 12 to switch from one mode (*corresponding translational motion of mouse cursor to translational motion of main cursor*) to another mode (*corresponding X_M translational motion of the mouse cursor to Z_C rotational motion of the main cursor*), or to a third mode (*corresponding X_M and Y_M translational motion of the mouse cursor to Y_C and Z_C rotational motion of the main cursor*), which Applicant submits has absolutely no correlation to the claimed switching *from one operating mode, where the gripping element is used for manipulating images, to another operating mode, where the device is used as a pointer or for selection* and vice versa.

In the claimed invention, the switching is between an image manipulation mode and pointer/selection mode, while in Takanashi the switching is between one kind of motion correlation and another or a third kind of motion correlation.

As such, Applicant submits that Takanashi falls wholly short of anticipating each and every element of the claimed invention arranged as claimed.

Second, and in further comparing Takanashi with the claimed invention, Applicant finds Takanashi to disclose motion of the main cursor 10 only when the mouse cursor 20 is overlapped with the main cursor 10 on screen 8A and a specific one of the buttons 12 is operated (col. 9, lines 48-51). As disclosed, the main cursor 10 is used to designate a *post-motion position and a post-motion attitude of a robot 16 and camera 5* (col. 8, lines 9-12). By providing *motion control instructions to the robot 16*, the position and/or attitude *of the camera 5* is changed in three-dimensional space (col. 8, lines 2-6).

Here, Applicant finds Takanashi to disclose element 12 for *manipulating a robot 16, which in turn manipulates a camera 5*.

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In view of the disclosure in Takanashi, Applicant submits that the robot/camera manipulation has absolutely no correlation to the claimed *one operating mode where the gripping element is used for manipulating images, or the claimed another operating mode where the device is used as a pointer or for selection*.

In the claimed invention, the mode involving manipulation is specifically directed to *image manipulation*, while in Takanashi the mode involving manipulation is specifically directed to *robot manipulation*. Applicant respectfully submits that robot manipulation is substantially different from image manipulation.

As such, Applicant submits that Takanashi falls wholly short of anticipating each and every element of the claimed invention arranged as claimed.

In view of Claims 1, 13 and 16 each including limitations directed to the above noted distinctions over the art of record, Applicant submits that Takanashi does not disclose each and every element of the claimed invention arranged as claimed and therefore cannot be anticipatory.

Dependent claims inherit all of the limitations of the respective parent claim.

Regarding Claim 13 More Specifically

Claim 13 includes a limitation to “manipulating *3D images*”, which Applicant submits is not disclosed in Takanashi in the manner claimed. As discussed above, Applicant finds Takanashi to disclose *manipulation of a robot 16, which in turn manipulates a camera 5*, which in turn provides a different view of a *2D image* (when the camera 5 is turned on, or strictly manipulates the robot and camera when the camera is turned off). As such, Applicant submits that not only does Takanashi fail to disclose manipulation of an image (manipulation of a robot being substantially different from manipulation of the claimed image), but also fails to specifically disclose manipulation of 3D images.

For at least this reason, Applicant submits that a prima facie case of anticipation has not been made at least with respect to Claim 13.

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In view of all of the foregoing, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(b) has been traversed, and requests that the Examiner reconsider and withdraw of this rejection.

Rejections Under 35 U.S.C. §103(a)

Claims 3-6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Takanashi in view of Reid et al. (U.S. Patent No. 6,853,365, hereinafter Reid).

Claims 7-12, stand rejected under 35 U.S.C. §103(a) as being unpatentable over Takanashi in view of Zagnoev (U.S. Publication No. 2003/0090394, hereinafter Zagnoev).

Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takanashi in view of Bonanni et al. (U.S. Patent No. 6,400,157, hereinafter Bonanni).

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Dependent claims inherit all of the limitations of the respective parent claim and any intervening claim.

In view of Claims 3-6, 7-12 and 14-15 being dependent claims, and in view of the secondary references not being applied against the parent claims, Applicant submits that Claims 3-6, 7-12 and 14-15 are allowable at least for the reason that they depend from an allowable claim.

In addition to the foregoing, Applicant finds no motivation or teaching in any of the References to modify the primary Reference of Takanashi (directed to manipulation of a robot in 3D space via a three-button mouse and 2D motion of the mouse) in view of

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any of the respective secondary References (Reid, Zagnoev and Bonanni, all unrelated to robot control) to arrive at the claimed invention, as the References as a whole fail to suggest the desirability, and thus the obviousness, of making the claimed combination (directed to other than robot control).

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, fail to motivate one skilled in the art to do what the patent Applicant has done, fail to recognize a problem recognized and solved only by the present invention, fail to offer any reasonable expectation of success in combining the References to perform as the claimed invention performs, and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

In light of the foregoing remarks and amendments, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, and that the application is now in condition for allowance. Such action is therefore respectfully requested.

If a communication with Applicant's Attorneys would assist in advancing this case to allowance, the Examiner is cordially invited to contact the undersigned so that any such issues may be promptly resolved.

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The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 50-2513. In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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